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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,391	02/24/2004	Raymond Bass	INDUCTION2-CONT	6526

7590 01/12/2005

DAVID G. HENRY
7th Floor
900 Washington Avenue
P.O. Box 1470
Waco, TX 77603-1470

EXAMINER	
LEUNG, PHILIP H	

ART UNIT	PAPER NUMBER
3742	

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/785,391	BASS, RAYMOND	
	Examiner	Art Unit	
	Philip H Leung	3742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-4 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-4 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 14 August 2004 is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 8-14-2004.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because only informal drawings have been filed. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

2. In the specification, at page 11, line 15; "two capacitors to 16" should read "two capacitors 16" instead. Correction is needed.

3. Claims 2-4 are objected to by the Examiner as being informal. In claim 2, the limitation "set power supply" at line 4 should read "said power supply" and "send first" at line 8 should read "said first". In claim 3, line 2; should "lawyers" be "layers" instead? The use of a period mark "." before the end of a claim (claim 3, line 19 and claim 4, line 19) must be avoided and should be replaced with a ";" mark instead. Clarification and correction are required.

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claim 4 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,700,104. This is a double patenting rejection. The only difference between claim 4 and the parent patented claim is a minor formality, for instance, a ";" instead of "." and the deletion of a redundant article "the". Therefore, the claim is virtually identical to the patented parent claim and must be cancelled.

6. Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,700,104 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are directed to an induction stripping of material with "an induction heating system comprising an electrical power supply; first electrical lead means electrically attached to said electrical power supply, said first electrical lead means for conducting electrical power from said electrical power supply to capacitor means; capacitor means electrically connected to said first electrical lead means; secondary lead means electrically connected to said capacitor means, said secondary lead means for conducting electrical currents to or from said capacitor means; stripping head means including an electrically conductive coil member electrically connected to said secondary lead means; actuating said electrical power supply". Moreover, the claims are broader in scope than the parent patent claim. It would have been obvious to use the system for stripping any suitable material other than rubber-like linings from chemical transport tank cars and trailers.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-3 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Lingnau (US 5,660,753), in view of Buckley et al (US 4,521,659) or Partridge et al (US 6,211,498) (cited by the applicant and in the parent application).

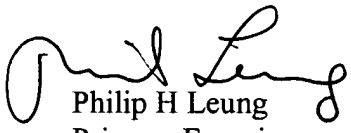
Lingnau discloses the claimed invention of an induction heating stripping device for removing coating bonded to a metal surface including electrical leads 22 and stripping head 20. It does not explicitly shows the circuit of the power supply with the use of capacitors (see Figures 1, 2 and 4 and col. 2, line 38 - col. 5, line 45). However, Buckley or Partridge shows that it is well known in the art of induction heating devices that it is essential to use capacitors to form a resonance circuit with the heating inductor to induce current to the work load to provide

induction heating (see Buckley, Figures 1, 4 and 5, col. 3, line 12-41 and col. 5, line 38 - col. 6, line 64 and Partridge, Figure 1 and col. 3, line 10 - col. 4, line 27). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Lingnau to include capacitors in order to form a resonant tank circuit with the heating inductor to produce induction heating at resonance for better heating efficiency and result, in view of the teaching of Buckley or Partridge.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip H Leung whose telephone number is (571) 272-4782.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robin Evans can be reached on (571) 272-4777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Philip H Leung
Primary Examiner
Art Unit 3742

P.Leung/pl
1-06-2005